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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,044	09/13/2003	David J. Laverick	702.270	1972

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EXAMINER	
LUU, MATTHEW	
ART UNIT	**PAPER NUMBER**
3663	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/663,044	LAVERICK ET AL.	
	Examiner	Art Unit	
	LUU MATTHEW	3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,13,14 and 30-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,13,14 and 30-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/7/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8, 13-14 and 31-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding the new added limitation to claims 1 and 31, "wherein the case is configured to substantially conform to the tray", this new limitation was not described in the specification as originally filed. In other words, it is not clear how exactly "the case is configured to substantially conform to the tray".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 13-14 and 31-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claims 1 and 31, the term "substantially conform to the tray" is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Dependent claims are considered rejected for incorporating the defects from their respective parent claims by dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8, 13 and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al (5,859,628) in view of Lewis (GB 2,405,049) and Susko et al (5,996,866).

Regarding claim 1, Ross discloses (Figs. 1-3) a navigation assembly for use in a vehicle comprising:

A navigational device (Fig. 2 shows a PDA 102 that has the capability of a GPS navigation device) (Column 8, line 64 to column 9, line 2; and column 9, lines 57-67); and this navigational device (PDA 102) is configured to removably fit within a tray (Fig.

3, the cradle 104). The tray (cradle 104) is mounted on the vehicle dashboard and is similar to those presently used for mounting cellular telephones in automobiles (Column 3, line 63 to column 4, line 5).

Ross fails to disclose a carrying case for enclosing the navigational device.

However, Lewis (GB 2,405,049) discloses (Fig. 3) a carrying case or a hard case (40) for carrying a mobile phone or a remote unit such as a PDA or a computer (Page 5, lines 1-5). This carrying case (40) also includes a GPS navigational device to be used while driving a vehicle (Page 7, lines 1-7).

Therefore, it would have been obvious to a person of ordinary skill in the art to use the carrying case (40) of Lewis for enclosing the navigational PDA device (102) of Ross to protect the navigational PDA from being damaged when a user wants to carry the navigation device on foot around an unfamiliar city or when driving a vehicle.

Regarding the new added limitation "wherein the case is configured to substantially conform to the tray", Susko (5,996,866) discloses (Figs. 1 and 4) a vehicle console (12) having a plurality of containing trays. Susko further teaches that one of the tray (drawer 16) is configured to receive a portable phone (22) in slot (18) and glasses (22) in slot (20).

Therefore, it would have been obvious to the person of ordinary skill in the art to store the carrying case (40) of Lewis in to the tray (16) of Susko to provide a more

convenient storing tray in the vehicle. This tray would allow the driver to easily reach for the GPS or portable phone when he needs it.

Furthermore, it is obvious that one of ordinary skill in the art to store the carrying case (40) on the vehicle dashboard tray, a cup holder tray, or the right hand console tray, as shown in Fig. 1 of Susko, since this is not critical to the function of the GPS device in the carrying case (40) of Lewis.

Regarding claim 2, it is well known in the art that a plurality of trays such as vehicle dashboard tray, a cup holder tray, or the driver's right hand console tray (as shown in Fig. 1 of Susko) can be installed during manufacture of the vehicle as a container for containing the drivers' articles such as sunglasses, drinking cup, or electronic devices.

Furthermore, if the vehicle has a tray, then it does not matter where it is come from or what time it is put in.

Regarding claim 3, Ross further teaches the tray (cradle 104) is mounted on the vehicle dashboard (Column 3, line 3 to column 4, line 5).

Regarding claim 4, Ross discloses (Figs. 1, 4 and 5) the tray (104) includes electrical connections for connecting the navigational device to a power source and data source supplied by the vehicle (Column 3, lines 16-37).

Regarding claim 5, Lewis (GB 2,405,049) discloses (Fig. 3) the carrying case (40) includes a base (42) and a hinged lid (44).

Regarding claim 6, it is obvious that the carrying case (40) of Lewis "may" easily and quickly be removed from the tray (16) of Susko.

Regarding claim 7, Lewis further teaches that the carrying case (40) can function as a tuner, a radio, television, or musical MP3 player (Page 7, lines 17-24). It is well known that these above mentioned electronic devices contain speakers.

Regarding claims 8 and 13, Lewis (GB 2,405,049) discloses (Fig. 3) the carrying case (40) comprises a cellular phone or can function as a tuner, a radio, television, or musical MP3 player (Page 7, lines 11-35; and page 7, lines 17-24). It is well known that these above mentioned electronic devices contain speakers.

Furthermore, whether positioning the electronic devices on the base or on the lid of the case is merely an obvious design choice since it is not a critical function to the navigational device.

Regarding claim 31, note the rejection as set forth above with respect to claim 1. Furthermore, it is well known in the art that a plurality of trays such as vehicle dashboard tray, a cup holder tray, or the driver's right hand console tray (as shown in

Fig. 1 of Susko) can be installed during manufacture of the vehicle as a container for containing the drivers' articles such as sunglasses, drinking cup, or electronic devices.

Furthermore, if the vehicle has a tray, then it does not matter where it is come from or what time it is put in.

Regarding claims 32-36, note the rejections as set forth above with regard to claims 3-7, respectively.

Claim Rejections - 35 USC § 103

Claims 14 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross in view of Lewis as applied to claim 1 above, and further in view of Ockerse et al (6,928,366).

Regarding claims 14 and 38, Ross fails to disclose the structure of the GPS device.

However, Ockerse discloses (Fig. 3) a GPS device includes a navigation component (GPS 118 and magnetic sensor circuit 102), a processor (110), a memory (non-volatile memory 112), a display (heading indicator 114), an input (user input 116), and it is well known in the art that these well known components are assembled in the housing. See column 9, line 40 to column 10, line 30.

Therefore, it would have been obvious to the person of ordinary skill in the art to use the GPS device of Ockerse for the GPS device of Ross to provide a more accurate navigation device.

Claim Rejections - 35 USC § 103

Claims 30, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross in view of Lewis as applied to claims 1 and 31 above, and further in view of Yaski et al (US 2001/0040109).

Regarding claims 30, 37 and 39, Lewis discloses (Fig. 4) the carrying case (40) includes a base (50) and a hinged lid (44).

Both of Ross and Lewis fail to disclose the lid is "operable" to enclose the navigational device, and the lid is "operable" to pivot upwards and rest generally against a top of the navigational device.

However, Yaski (US 2001/0040109) discloses (Fig. 1) a carrying case with a base (2) and a hinged lid (22). The hinged lid (22) is "operable" to enclose the navigational device (GPS 26) when the base (2) is sitting on a flat surface. The hinged lid (22) is also "operable" to pivot upwards and rest generally against the top (28) of the navigational device (26) (Section 2, the last seven lines).

Therefore, it would have been obvious to a person of ordinary skill in the art to use the carrying case with the hinged lid (22) of Yaski for enclosing the navigational PDA device (102) of Ross to protect the navigational PDA from being damaged. Furthermore, this carrying case also allows the user to adjust the viewing angle of the navigational device at any desired position.

Furthermore, regarding the term "**operable** to function independently..."

The statements of intended use or field of use, "operable to", "adapted to', or "capable of" clause are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentable distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP 2114:

"A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ 2nd 1525, 1528."

As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Response to Arguments

Applicant's arguments with respect to claims 1-8, 13-14 and 30-39 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's election with traverse of Group I and Species I (Fig. 19, carrying case) in the reply filed on November 29, 2005 is acknowledged. The traversal is on the ground(s) that "Applicant believes all claims read on the elected invention and species". This is not found persuasive because the inventions Group I and Group II are related as product and process of use. In the instant case, the process as claimed can be practiced by another materially different apparatus such as a DVD player being installed in the overhead console.

Furthermore, inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUU MATTHEW whose telephone number is (571) 272-7663. The examiner can normally be reached on Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JACK KEITH can be reached on (571) 272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Luu

MATTHEW LUU
PRIMARY EXAMINER